

Appln. No. 08/904,056  
Amendment dated October 18, 2006  
Reply to Office Action mailed July 27, 2006

### REMARKS

Reconsideration is respectfully requested.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal.

Claims 23, 26 through 32, 34, 37 through 44 and 46 through 49 remain in this application. Claims 1 through 22, 24, 25, 33, 35, 36 and 45 have been cancelled. No claims have been withdrawn or added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

#### Paragraphs 1 through 4 of the Office Action

Claims 23, 32, 34, 39, 41 and 47 through 49 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Schultheiss in view of Amano.

Claims 26, 37 and 42 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Schultheiss in view of Amano and applicant's (allegedly) admitted prior art as applied to claims 23, 32, 34, 39 and 41 and further in view of Hall.

Claims 27 through 31, 38, 40, 43, 44 and 46 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Schultheiss in view of Amano and Applicant's admitted prior art as applied to claims 23, 24 and 41 and further in view of Schindler.

Claim 23 requires, in part, "a housing having a bottom wall for resting on a surface during use and an upper wall extending upwardly from a perimeter of the bottom wall that defines an interior of the housing above the bottom wall", "a mouse button disposed on the upper wall of the housing to control

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an operation of the computer", "a cursor control device disposed on and extendable through the bottom wall of the housing such that movement of the bottom wall of the housing across the surface actuates the cursor control device", "at least one multimedia control device disposed on the upper wall of the housing, the at least one multimedia control device being configured to control only the multimedia device of the computer" and "a connection that transmits signals generated by the mouse button, cursor control device and multimedia control device to the computer".

It is conceded in the final rejection of the claims in the Office Action that:

While Schultheiss teaches that the multimedia device is a trackball type remote device, including a cursor control device extendable through the upper wall of the housing, and a mouse button and at least one multimedia control located on the upper wall of the housing, there fails to be any teaching of the multimedia device having a housing arrangement which allows for the device to be operated on a surface wherein a cursor control device is disposed to be extendable through the bottom wall and an upper wall portion comprising a top wall portion and a perimeter wall portion extending between the top wall portion of the upper wall and the bottom wall, wherein the mouse button is disposed on the top wall and at least one multimedia control device being disposed on the perimeter wall portion of the upper wall, as recited in claims 23, 34, 41, and 47-49.

It is then contended in the rejection that:

However the examiner takes Official Notice that the usage of a trackball device and a mouse device as interchangeable devices are well known to those skilled in the art. Further to shift location of parts is not an invention (see *In re Japikse*, 86 USPQ 70 CCPA 1950). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to allow the multimedia device of Schultheiss to be carried out as a mouse type device allowing for the same functionality to thereby control a multimedia device in a manner which is easier for the user. .

However, it is noted that the device of the Schultheiss patent is disclosed as, and consistently referred to as, a "remote control" for controlling the operation of the television, and not simply as a "cursor control device".

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See, for example, Schultheis at col. 5, lines 23 through 30, where it is stated that:

Still referring to FIG. 1, wireless remote control 50 includes a remote control housing 52 and a user interface in the housing which accepts user input commands. As shown in FIG. 1, the user interface includes a plurality of keys 58 and 62, a trackball 64 and trackball keys 66a and 66b, as will be described in detail below. However, it will be understood by those having skill in the art that other user inputs may be provided via touch screen, voice activation and the like.

See also Schultheiss at col. 7, lines 3 through 17, where it states:

As shown in FIG. 4, system 100 includes a personal computer 12 as already described. However, PC interface card 22 includes a radio frequency (preferably UHF) transceiver, i.e. a UHF transmitter/receiver 24' which both receives UHF signals from remote control unit 50' and transmits UHF signals to television interface unit 200. Remote control unit 50' only includes a UHF transmitter 54 but does not include an infrared transmitter. Activation of the combined keys 58, the conventional television keys 52 and the personal computer keys 64, 66a, 66b are all communicated to the personal computer 12 via UHF signals. The television commands from keys 58 and 62 are communicated as UHF television commands 74a, and the personal computer commands from keys 58 and keys 64, 66a and 66b are communicated as PC commands 74b.

Even though the Schultheiss remote control has a trackball capable of controlling a cursor of a computer, it is clear from the Schultheis patent that the remote control is intended to control the television, even if that control is executed through the computer. Further, the television remote control of Schultheiss is clearly intended to be held in the hand of the user during use, which is known by those skilled in the art to be true of virtually all television remote controls. Still further, the Schultheiss remote control discloses that *all* of the controls (buttons) on the same (upper) planar surface of the remote control, and lacks any controls on any other surface of the remote control, which one of ordinary skill in the art recognizes as being consistent with conventional television remote controls. One of ordinary skill in the art recognizes that all of the button controls on the remote control are located on the upper surface of the remote control

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housing to facilitate the operation of the buttons by the fingers of the user while the hand of the user holds the remote control.

It is submitted that one of ordinary skill in the art would not be motivated to change the configuration of the Schultheiss television remote control to a form (as required by the claims) that would not be suitable for including all of the buttons performing all of the functions of the Schultheiss remote control on the same upper surface of the remote control housing. More particularly, one of ordinary skill in the art does not recognize that the structure of a "mouse type device" would suitably perform the functions required of the Schultheiss remote control. These functions include being capable of the being operated by the hand of the user while being supported by the hand of the user, so that no flat surface is required to be engaged by the remote control in order to operate the remote control. Further, it is submitted that one of ordinary skill in the art would not understand how to incorporate all of the functions buttons on the housing of a "mouse type device" that meets the requirements of the claim. It is noted that the question of obviousness is not merely a question of what can be done, or what one of ordinary skill in the art is capable of doing, but instead is a question of what one of ordinary skill in the art would have been motivated to do by the prior art. It is submitted that, even if one believes that the "trackball" of the Schultheiss remote control could be moved to a different surface of the housing of the remote control, he or she would not be motivated to do so in light of the considerations and functional requirements of the Schultheiss teaching.

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Schultheiss, Amano, applicant's (allegedly) admitted prior art, Hall, and Schindler set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 23, 34 and 41. Further, claims 26 through 32, 47 and 48, which depend from claim 23, claims 37 through 40, which

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depend from claim 34, claims 42 through 44, which depend from claim 41, claim 46, which depends from claim 34 and claim 49, which depends from claim 48 also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Withdrawal of the §103(a) rejection of claims 23, 27 through 32, 34, 37 through 43 and 46 through 49 is therefore respectfully requested.

### CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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